

The opinion in support of the decision being entered today was not written for publication and is **not** binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JASON SULAK, ANDREW COHEN
and BRUCE PETRO

Appeal No. 2004-2283
Application 09/629,370

ON BRIEF

MAILED

JAN 21 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before GROSS, MACDONALD, and NAPPI, **Administrative Patent Judges**.

MACDONALD, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-5 and 8-26. Claims 6-7 have been canceled.

Invention

Appellants' invention relates to a system, method, and code means for on-line creation of a printable product, the system comprising: (1) at least one server accessible via a computer network, said at least one server storing defining data defining a plurality of printable products including one or more design elements, and a first program providing modification functions for modifying the defining data, and assembly functions for assembling a printable product suitable for printing; and (2) a client computer for accessing said server, wherein said at least one server downloads said first program to said client computer. Appellants' specification at page 2, line 22, through page 3, line 18.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A system for on-line creation of a printable product, the system comprising:

at least one server accessible via a computer network, said at least one server storing defining data defining a plurality of printable products including one or more design elements, and a first program providing a user with modification functions for modifying the defining data, and assembly functions for assembling a printable product suitable for printing;

a client computer for accessing said server, wherein said at least one server downloads said first program and said defining data to said client computers; and

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a printer operatively coupled with said client computer, wherein said first program assembles printing data for printing the printable product on the printer.

References

The references relied on by the Examiner are as follows:

Cannon et al. (Cannon)	5,552,994	Sept. 3, 1996
Gennaro et al. (Gennaro)	5,742,768	Apr. 21, 1998
Rhoads	6,311,214	Oct. 30, 2001
		(Filed June 29, 1999)

Rejections At Issue

Claims 10-12 stand rejected under 35 U.S.C. § 102 as being anticipated by Rhoads.

Claims 13 and 26 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Rhoads and Cannon.

Claims 1-5, 14-19, and 22-25 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Rhoads and Gennaro.

Claims 8-9 and 20-21 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Rhoads, Gennaro, and Cannon.

Throughout our opinion, we make references to the Appellants' brief, and to the Examiner's Answer for the respective details thereof.¹

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claims 10-12 under 35 U.S.C. § 102, and we reverse the Examiner's rejection of claims 1-5, 8-9, and 13-26 under 35 U.S.C. § 103.

We also use our authority under 37 CFR § 41.50(b) to enter a new ground of rejection of claims 10-13 and 26. The basis for this is set forth in detail below.

Appellants have indicated that for purposes of this appeal the claims stand or fall together as grouped. We read "as grouped" as "as grouped by the rejections" with:

Claims 10-12 as Group I;

Claims 13 and 26 as Group II;

Claims 1-5, 14-19, and 22-25 as Group III; and

Claims 8-9 and 20-21 as Group IV.

¹Appellants filed an appeal brief on January 14, 2004. The Examiner mailed an Examiner's Answer on April 7, 2004.

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See pages 2 and 4 of the brief. Appellants have fully met the requirements of 37 CFR § 1.192 (c)(7) (July 1, 2003) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellants' filing of the brief. 37 CFR § 1.192 (c)(7) states:

Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider Appellants' claims as standing or falling together in the four groups noted above, and we will treat:

Claim 10 as a representative claim of Group I;
Claim 13 as a representative claim of Group II;
Claim 1 as a representative claim of Group III; and
Claim 8 as a representative claim of Group IV.

If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal of that rejection based solely on the selected representative

claim. **In re McDaniel**, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). **See also In re Watts**, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004).

**I. Whether the Rejection of Claims 10-12 Under
35 U.S.C. § 102 is proper?**

It is our view, after consideration of the record before us, that the disclosure of Rhoads does not fully meet the invention as recited in claims 10-12. Accordingly, we reverse.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. **See In re King**, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and **Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.**, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

With respect to independent claim 10, Appellants argue at page 6 of the brief, "Rhoads is completely silent about modifying the browser program." The Examiner responds at page 13 of the answer that, "[t]he web pages and web browser are all entailed into one, wherein changes to a web pages [sic] or modifications to a web page can be interpreted as modifications to a web browser program." We do not agree with the Examiner's position.

To determine whether claim 10 is anticipated by the reference, we must first determine the scope of the claim. Our reviewing court states in **In re Zletz**, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) that "claims must be interpreted as broadly as their terms reasonably allow." Our reviewing court further states, "[t]he terms used in the claims bear a 'heavy presumption' that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art." **Texas Digital Sys. Inc v. Telegenix Inc.**, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002), **cert. denied**, 538 U.S. 1058 (2003).

Upon our review of Appellants' specification, we fail to find any definition of the term "browser" that is different from the ordinary meaning. We find the ordinary meaning of the term "browser" is best found in the dictionary. We note that the definition most suitable for "browser" is "A program that accesses and displays files and other data available on the Internet and other networks."²

We appreciate the Examiner's position that "browser" includes the "files and other data". However, we find that the claim language precludes a reading that includes the "files and

² *The American Heritage Dictionary of the English Language, Fourth Edition Copyright 2000 by Houghton Mifflin Company.*
Dictionary.com. Copy provided to Appellant.

other data" that are modified as being part of the "browser" program itself. These are clearly separate things. We find that modifying a web page cannot reasonably be interpreted as modifying the web browser program.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 102.

II. Whether the Rejection of Claims 13 and 36 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 13 and 26. Accordingly, we reverse.

With respect to dependent claim 13, we note that the Examiner has relied on the Cannon reference solely to teach "specific formatting layout means" [answer, page 11]. The Cannon reference in combination with Rhoads fails to cure the deficiencies of Rhoads noted above with respect to claim 10. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103 for the same reasons as set forth above.

**III. Whether the Rejection of Claims 1-5, 14-19, and 22-25
Under 35 U.S.C. § 103 is proper?**

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 1-5, 14-19, and 22-25. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must

necessarily weigh all of the evidence and argument." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 1, Appellants argue at page 9 of the brief, "Gennaro et al. fails to provide the user with the ability to modify data defining decorative designs" and "[T]here would be no motivation for one of ordinary skill in the art to download a program to the user's computer to perform the modification of the defining data when apprised of the teachings of Rhoads and Gennaro et al." We agree. The Examiner's response at page 15 of the answer is a general allegation that Appellants are in error without citation to any language in the reference to support the Examiner's position. We do not find the Examiner's response to be persuasive.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

IV. Whether the Rejection of Claims 8-9 and 20-21 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 8-9 and 20-21. Accordingly, we reverse.

With respect to dependent claim 8, we note that the Examiner has relied on the Cannon reference solely to teach "specific formatting means" [answer, page 12]. The Cannon reference in combination with Rhoads and Gennaro fails to cure the deficiencies of Rhoads and Gennaro noted above with respect to claim 1. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103 for the same reasons as set forth above.

V. Rejection of Claims 10-13 and 26 Under 37 CFR § 41.50(b).

We make the following new ground of rejection using our authority under 37 CFR § 41.50(b).

Claims 10-13 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The sequence of the means in claim 10 creates an antecedent basis problem. Line 5 of claim 10 refers to "the defining data." However, the basis for "the defining data" does not occur until line 6 as "means for downloading data defining a printable product." This problem stems from lines 4 and 5 being inserted by amendment before the "means for downloading" rather than after this means. Appropriate correction is required.

Other Issues

The Board of Patent Appeals and Interferences is a review body, rather than a place of initial examination. We have cited three patents that we believe together with the references cited by the Examiner teach all the components of the claimed invention. For example, Leone III et al. (U.S 6,704,120) teach at column 8, lines 49-63, that a greeting card designer can use a downloaded applet to modify the function of a browser. Leone III et al. also teach defining data (item 56), but do not appear to teach downloading the design data. Finkel (6,494,571) at column 1, line 38, and McCue, Jr. et al. (6,364,553) at column 2, line 40, both teach downloading greeting card design data from the Internet.

We have not reviewed the references to the extent necessary to determine whether there is sufficient motivation to combine these references to yield the claimed invention. We leave it to the instant Examiner to determine the appropriateness of any rejections based on these references.

Conclusion

In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 102 of claims 10-12, and we have not sustained the rejection under 35 U.S.C. § 103 of claims 1-5, 8-9, and 13-26. We have entered a new ground of rejection against claims 10-13 and 26 under 37 CFR § 41.50(b).

As indicated **supra**, this decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, by final rule notice, 69 Fed. Reg 49960, 50008 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21, 61 (September 7, 2004)). 37 CFR § 41.50(b) provides that, "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

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37 CFR § 41.50(b) also provides that the Appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 CFR § 1.197 (b) (amended effective September 13, 2004)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . .
- (2) Request that the proceeding be reheard under 37 CFR § 41.52 by the Board upon the same record . . .

REVERSED
37 CFR § 41.50(b)

Anita Pelleman Gross

ANITA PELLMAN GROSS)
Administrative Patent Judge)

Allen Macdonald)
ALLEN R. MACDONALD)
Administrative Patent Judge)

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Application/Control No.
09/629,370Applicant(s)/Patent Under
Reexamination**Notice of References Cited**

Examiner

Raymond J. Bayerl

Art Unit

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U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification	
	A	US-6364553	04-2002	McCue, Jr. et al.	--	--
	B	US-6494571	12-2002	Finkel	--	--
	C	US-6704120	03-2004	Leone III et al.	--	--
	D	US-				
	E	US-				
	F	US-				
	G	US-				
	H	US-				
	I	US-				
	J	US-				
	K	US-				
	L	US-				
	M	US-				

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
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NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	The American Heritage Dictionary of the English Language, Fourth Edition Copyright 2000, Houghton Mifflin Company.
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
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